

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 28, 2005. In order to advance prosecution of this Application, Claims 1, 11, and 16 have been amended. Applicant respectfully requests reconsideration and favorable action in this Application.

With respect to Claims 6, 7, and 9 withdrawn by the Examiner, Applicant respectfully submits that these claims depend from a generic claim, Claim 1. Upon allowance of generic Claim 1, Applicant respectfully requests that non-elected Claims 6, 7, and 9 be reinstated.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified in the claims. FIGURE 14 has been amended to show the midsole described in the specification but missing from the drawings. No new matter has been added as a result of showing the midsole in the drawings. Support for the amendment to the drawings to show the midsole can be found at page, See page 29, lines 11-13, of Applicant's specification. Further support for a midsole can be found at page 22, lines 9-12, of Applicant's specification. FIGURE 14 has also been amended to reposition reference numeral 824 so that it coincides with the midpoint of the length of shoe 810 as provided in Applicant's specification at page 29, lines 16-20, therein. Therefore, Applicant respectfully submits that the drawings are in accordance with 37 C.F.R. §1.83(a).

Claims 1-5, 8, and 10-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 11, and 16 have been amended to address matters raised by the Examiner by including structural limitations as requested. Therefore, Applicant respectfully submits that Claims 1-5, 8,

and 10-20 are in accordance with 35 U.S.C. §112, second paragraph.

Claims 1, 2, 10, and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lodispoto. Independent Claims 1 and 11 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section, and a planar outsole where a surface of the rear heel section is closer to the outsole than a surface of the forward toe section. By contrast, the top member or insole of the wooden shoe in the Lodispoto patent does not have a rear heel section surface closer to an outsole than a forward toe section as provided by the claimed invention. Moreover, the Lodispoto patent clearly shows a raised heel portion that prevents a wearer's heel from being closer to a walking surface than a wearer's toes as required in the claimed invention. See the Abstract of the Lodispoto patent and the upwardly bent backend stretch 28. In addition, the Lodispoto patent does not have a planar outsole as provided by the claimed invention. Support for the above recitation can be found at page 29, lines 7-9, of Applicant's specification. Therefore, Applicant respectfully submits that Claims 1, 2, 10, and 11 are not anticipated by the Lodispoto patent.

Claims 1-5 and 10-13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Snabb, et al. Independent Claims 1 and 11 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section, and a planar outsole, where a surface of the rear heel section is closer to the outsole than a surface of the forward toe section. By contrast, the Snabb, et al. patent clearly discloses that its insole 24 is substantially flat both laterally and longitudinally from heel to toe and that the slope is provided by its non-planar outer sole 20.

See FIG. 2 and col. 3, lines 50-53, of the Snabb, et al. patent. Thus, the Snabb, et al. patent fails to show an insole with a rear heel section being closer to a planar outsole than a forward toe section thereof as required in the claimed invention. Therefore, Applicant respectfully submits that Claims 1-5 and 10-13 are not anticipated by the Snabb, et al. patent.

Claims 1-5, 8, 10-14, and 16-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson. Independent Claims 1, 11, and 16 recite in general an upper, an insole being a single piece layer and having a forward toe section and a rear heel section, and a planar outsole where a surface of the rear heel section is closer to the outsole than a surface of the forward toe section. By contrast, the insole 30 of the Robinson patent is substantially planar and cannot provide a structure where a rear heel section surface is closer to an outsole than a forward toe section surface as provided by the claimed invention. Thus, the Robinson patent does not provide an insole structure that is a single piece layer having a surface of a rear heel section being closer to an outsole than a surface of a forward toe section as specified in the claimed invention. The Examiner merely provides a subjective conclusory "it would have been obvious" reason that the Robinson patent could be modified to incorporate its reverse wedge into its insole. However, without an improper hindsight reconstruction of the prior art based on the disclosure of the claimed invention, the Examiner has not provided any objective evidence to support the proposed modification of the prior art as has been proposed. Therefore, Applicant respectfully submits that Claims 1-5, 8, 10-14, and 16-20 are patentably distinct from the Robinson patent.

Claims 8, 14, and 16-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Snabb, et al. Independent Claim 1, from which Claim 8 depends; Independent Claim 11, from which Claim 14 depends; and Independent Claim 16 that includes similar limitations found in Independent Claims 1 and 11 have been shown above to be patentably distinct from the Snabb, et al. patents. Therefore, Applicant respectfully submits that Claims 8, 14, and 16-20 are patentably distinct from the Robinson and Snabb, et al. patents.

Claims 15 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson or Snabb, et al. Independent Claim 11, from which Claim 15 depends, has been shown above to be patentably distinct from the Robinson and Snabb, et al. patents. Therefore, Applicant respectfully submits that Claim 15 is patentably distinct from the Robinson and Snabb, et al. patents.

Claims 1-5, 8, and 10-20 stand rejected under the judicially created doctrine of double patenting over Claims 1-6 of U.S. Patent No. 6,131,315 in view of either Lodispoto, Robinson, or Borgeas. U.S. Patent No. 6,131,315 only provides disclosure through FIGURE 10 and does not include a FIGURE 14 of the elected species or any disclosure associated therewith as provided in Applicant's specification. Thus, the elected species of FIGURE 14 is not disclosed in U.S. Patent No. 6,131,315. Moreover, Claims 1-6 of U.S. Patent No. 6,131,315 are directed to specific features associated with an outsole of a shoe whereas the claims of the present Application are directed to features associated with an insole of a shoe. Therefore, Applicant respectfully submits that the claimed invention is patentably distinct from the Examiner's proposed combination and a Terminal Disclaimer is not necessary in this Application with respect to U.S. Patent No. 6,131,315.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If there are matters that can be discussed by telephone to advance prosecution of this Application, Applicant invites the Examiner to contact the undersigned attorney at the number provided below.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read "Charles S. Fish", written over a horizontal line.

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September 28, 2005

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